

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 22, 2010. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-4, 6-18, and 20 were rejected, and Claims 5 and 19 were objected to as containing allowable subject matter but depending from rejected claims. Claims 1 and 17 have been amended. Applicants respectfully request reconsideration and favorable action in this case.

At the time of the invention, the inventors were employees of Applicant and, thus, the subject matter claimed was commonly owned by the Applicant.

Allowable Subject Matter

Applicants appreciate Examiner's consideration and indication that Claims 5 and 19 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. However as stated below, Applicant believes that all independent claims as amended are allowable in view of the cited prior art.

Rejections under 35 U.S.C. §103

Claims 1, 4 and 8-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,418,980 issued to Glendon M. Benson ("*Benson*") in view of U.S. Patent No. 2,922,614 issued to Stanley W. Nickells ("*Nickells*")

Applicant amended independent claims 1 and 17 to more clearly define the subject matter. According to the present specification, in particular Figs. 2-5, the metering device comprises an actuator 2 with a first end cap 3'. This end cap 3' is operated by the actuator 2 to move within the housing 1. Most importantly, the end cap 3' engages with the sealing element 6 to open the metering device. The Examiner stated that *Benson* discloses all the elements of independent claim 1 with the exception of the hydraulic compensation element. Applicant respectfully disagrees. The claim amendments reflect this functionality. hence no new matter has been introduced.

Benson discloses an entirely different kind of metering device. According to *Benson* the operation of his fuel injector can be compared with that of a pump. In a first movement downwards, the plunger 38 which has an integrated first sealing element 42 allows for more fuel to enter the annular space 36. By retracting, the sealing element 42 opens and the fuel enters the space 46. *See Benson*, col. 3, line 51 to col. 4, line 19. Thus, fuel is basically pumped into the space 46 until the pressure inside space 46 is large enough to open the second sealing element 54. Hence, *Benson* does not teach a metering device with an actuator having an end cap that engages with the sealing element as claimed. The only sealing element with which the end cap 38 makes contact is sealing element 42. However, this is an internal sealing element and not the sealing element that opens the metering device. Thus, end cap 38 does not engage with the second sealing element 54 which actually opens the injection valve. For this reason, a combination of *Benson* with *Nickells* cannot render the independent claims obvious.

Claims 2, 3, 6, 7, 17, 18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benson in view of Nickells and further in view of U.S. Patent Application Publication No. 2002/0139863 filed by Jack Lorraine et al. ("Lorraine")

With respect to independent claim 17, similar amendments have been made as explained above. As the rejection is based on similar arguments as presented with respect to claim 1, the same arguments as presented above apply also to claim 17.

Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

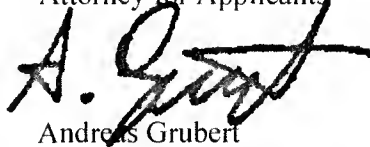
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe that there are no fees due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefor, and direct the Commissioner to charge any additional fees necessary or credit any overpayment to King & Spalding L.L.P. deposit account No. 50-4871, reference 03869.105608.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-457-2025.

Respectfully submitted,
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